PATENT
Attorney Docket No. 7393/71602

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

GLITTENBERG et al.

Art Unit: 1755

Application No.: 09/884,420

Examiner: David Brunsman

Filed: June 20, 2001

For: STARCH COMPOSITIONS AND THE USE THEREOF IN WET-END OF PAPER PREPARATION

December 12, 2003

RESPONSE

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop **AF**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Dear Sir:

Applicants renew their request for reconsideration.

The present application is claiming a different invention than in USP 6,413,372 B1 inasmuch as the rejection is *only* under 35 U.S.C. 102(**e**) and the Declaration evidence of record effectively removes the cited patent as prior art under Section 102(e). It is well known that "Rule 131 permits antedating patents or publications qualifying as prior art under 35 U.S.C. §102(a) or 102(e)." Chemical Patent Law, volume 2, page 10-2 (PRG 1996). It follows that 37 C.F.R. 1.608(p) is inapposite and the Declaration places this case in condition for allowance. The Declaration shows conception before the earliest date alleged by the Examiner for the cited patent, namely a conception date before April 20, 1999. (The Examiner has not provided a copy of the application having an April 20, 1999 filing date.)

The Declaration also reports that samples of the present composition were prepared before April 20, 1999: "[t]he samples were prepared prior to April 20, 1999" and that "two new samples" were also "prepared prior to April 20, 1999." It clearly follows that the Declaration establishes conception prior to April 20, 1999 and diligence spanning April 20, 1999 until further work was completed and, in the alternative, the Declaration shows reduction to practice before April 20, 1999. Accordingly, the cited patent is not prior art under 35 U.S.C. §102(**e**), and claims 1, 2, 4 and 9-12 define novel unobvious inventions over the cited U.S. patent.

The conclusion follows since the rejection was only under 35 U.S.C. §102(**e**) and the present application is not claiming the same invention - 35 U.S.C. §101 - as the cited patent.

The remaining obviousness rejection of claim 3 should likewise be reconsidered and withdrawn. The primary reference is only cited as prior art under 35 U.S.C. §102(e) in order to be combined with another reference to advance an obviousness rejection under 35 U.S.C. §103(a). However, if the primary reference is antedated, which it has been, then it is disqualified as prior art under 35 U.S.C. §102(e) so that the obviousness rejection should fall as well.

If the Examiner disagrees or has any questions, he is invited to telephone the undersigned to arrange for a personal interview. Otherwise, a notice of allowance is respectfully requested.

Respectfully submitted,

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By: _____

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